

REMARKS

This amendment is responsive to the Office Action mailed May 1, 2007. Claims 1-92 and 98-128 are pending in the application. Claims 1, 22, 112, 117, 122, 127, and 128 have been amended. Claim 21 has been canceled.

The Office Action rejected Claims 112-116 and 122-126 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Furthermore, Claims 1-18, 20-41, 43-65, 67-81, 86, 89-92, 104-108, and 111-128 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wallman (US 6,601,044). Claims 19 and 66 were rejected as being unpatentable over Wallman as applied to Claims 15 and 62 in view of Korhammer (US 6,278,982). Claim 42 was rejected as being unpatentable over Wallman as applied to Claim 40 in view of Minton (US 6,014,643). Claims 82-85 were rejected as being unpatentable over Wallman as applied to Claim 1 in view of Gutterman (US 5,297,031). Claims 87 and 88 were rejected as being unpatentable over Wallman in view of Jain (US 6,343,278). Claims 98-103 were rejected as being unpatentable over Wallman as applied to Claim 1 in view of May (US 6,317,727). Claims 109 and 110 were rejected as being unpatentable over Wallman in view of "More" (article). Having reviewed the cited art and the comments provided in the Office Action, and in view of the amendments to Claims 1, 112, 117, 122, 127, and 128, applicant requests withdrawal of the claim rejections and allowance of the application.

Interview Summary

The undersigned counsel thanks Examiner Milef and Examiner Abdi for the time and consideration they extended in a personal interview conducted August 30, 2007. The interview focused primarily on the issues under Section 112 and Section 103, and the patentability of the claims over Wallman '044. At the conclusion of the interview, applicant agreed to formally submit an amendment for further consideration

Written Description

Applicant submits that Claims 112-116 and 122-126 meet the written description requirement of 35 U.S.C. § 112, first paragraph. The Office Action alleged that the specification, as originally filed, does not provide support for the claimed feature of enabling multiple orders of a user to interact with at least one market process. Applicant respectfully disagrees.

As explained at page 4, lines 25-28, an order ELF (oE) is a trading process. An order room 70 is a user (see page 5, line 16: "... external users 70 and 72 shown as order rooms 70 and 72) and is coupled to oEs 10 and 11 as shown in FIGURE 1 and described at page 4, lines 22-23. See also page 5, lines 16-22, especially lines 18-19, where the specification explains: "A user may be represented via one or more order ELFs (oEs) . . . " Order umpires (oUs) constitute market processes. See page 5, lines 1-3. As can be observed in FIGURE 1, oEs 10 and 11 represent multiple orders of a user (order room) 70 and enable the orders of the user to interact with at least one market process oU 30.

Applicant requests withdrawal of the claim rejections under Section 112.

Patentability of Claim 1

For convenience of examination, amended Claim 1 is repeated as follows:

1. A method for enabling an order to interact with at least one market process, comprising:
 - configuring a trading process in accordance with the order, wherein the order identifies an item for trading,
 - automatically performing, at the trading process, market discovery according to a discovery strategy selected from a plurality of discovery strategies by a user, wherein the discovery strategies are configured to obtain market information for the item in the order according to different discovery methodologies, and wherein the selected discovery strategy includes automatically sending a trial order to the at least one market process and receiving a report from the market process indicating how the trial order would have been paired if it had been a regular order, said report providing information about current market depth for the item at a price, and

after performing said market discovery, automatically acting upon the order at the trading process according to an action strategy selected from a plurality of action strategies by the user,
wherein the at least one market process and the trading process are software programs operative on the same trading platform,
wherein the trading process is configured with the order, the discovery strategy, and the action strategy prior to automatically performing said market discovery, and
wherein the trial order is not a regular order to buy or sell and does not result in a trade for the item in the order.

The disclosure of Wallman does not teach or suggest all of the elements of Claim 1. Wallman provides a system that is directed to help individual or "small" investors define and execute an individual investment portfolio. After the investor's portfolio is defined, the investor can save costs by having trades aggregated with trades of other investors for combined execution. By aggregating one investor's trades with other investors' trades, the system enables an investor to invest a small amount of money (such as \$100 per month, see Col. 20, line 14) while still achieving the benefits of having risk spread across a portfolio of securities. See Col. 20, line 63, to Col. 21, line 20.

In one aspect, Wallman does not disclose the claim element of "automatically performing, at the trading process, market discovery according to a discovery strategy selected from a plurality of discovery strategies by a user, wherein the discovery strategies are configured to obtain market information for the item in the order according to different discovery methodologies."

With respect to this element, the Office Action quoted Wallman at Col. 30, lines 32-40. This passage, however, does not teach "performing . . . market discovery according to a discovery strategy selected from a plurality of discovery strategies by a user," as claimed. At best, this passage teaches a process of *selecting stocks* for investment. Specifying a stock selection strategy is not the same as selecting a strategy for performing market discovery.

This element of Claim 1 is further distinguished by stating "the discovery strategies are configured to obtain market information for the item in the order according to different discovery methodologies." Wallman does not teach this feature.

Indeed, the Office Action conceded that Wallman does not explicitly state that market discovery is performed. To cure this deficiency, the Office Action suggested "that if an investor would like information on the trading price or a suggested portfolio based on a selected strategy as taught by Wallman, that some type of market discovery or research into the price of the security must be performed." Despite the fact that conducting "some type of market discovery" requires conjecture, the suggestion in the Office Action makes it clear that Wallman does not teach a plurality of discovery strategies "configured to obtain market information for the item in the order according to different discovery methodologies."

In contrast, the present application describes multiple discovery methodologies from which a user can select. For example, in addition to querying current market data (i.e., at a formal market), another discovery methodology includes obtaining price information from an informal market that is not subject to government trading regulation (see, e.g., page 24, lines 4-7, of the present application). Another discovery methodology involves sending a trial order to a market and receiving information reporting how the trial order would have been paired had it been a regular tradable order (see, e.g., page 27, lines 1-20). Yet another discovery methodology may obtain order depth information at a price other than the current posted market price (see, e.g., page 80, lines 9-13). Another discovery methodology may send an inquiry to a market to discover whether there is a contra-party trading process interested in trading the item (see, e.g., page 117, lines 20-31). Still another discovery methodology provides a price inquiry to a market to have the market obtain a crowd price improvement over the current posted market price (see, e.g., page 29, lines 14-30).

Claim 1 has also been clarified to distinguish over the stock picking process taught by Wallman by reciting the element of "configuring a trading process in accordance with the order,

wherein the order identifies an item for trading . . . wherein the trading process is configured with the order, the discovery strategy, and the action strategy prior to automatically performing said market discovery." The Office Action contended that Wallman's process of suggesting stock portfolios constitutes the claimed market discovery. However, according to Claim 1, the trading process is configured with the order, the discovery strategy, and the action strategy *prior to* automatically performing said market discovery.

Claim 1 further recites "after performing said market discovery, automatically acting upon the order at the trading process according to an action strategy selected from a plurality of action strategies by the user" which is not taught or suggested by Wallman. According to Wallman, after a portfolio is selected, the investor must provide further input to the system to implement the portfolio and place an order for the securities in the portfolio.

In addition, Claim 1 recites that "the selected discovery strategy includes automatically sending a trial order to the at least one market process and receiving a report from the market process indicating how the trial order would have been paired if it had been a regular order, said report providing information about current market depth for the item at a price . . . wherein the trial order is not a regular order to buy or sell and does not result in a trade for the item in the order."

As noted above, in one aspect, discovery may be accomplished according to a discovery methodology by sending a trial order to a market. Information is thereafter received from the market reporting how the trial order would have been paired had it been a regular tradable order. A discussion of trial orders and how they are treated by the market and distinguished from regular orders is provided at page 8, lines 20-24; page 27, lines 1-20; and page 114, line 4, to page 115, line 3). The present application includes other references as well that describe trial orders and their use in various embodiments. See the description of FIGURE 70 at page 85, line 9, to page 86, line 4 (especially page 85, lines 17-20 and 25-28).

Claim 21 has been canceled as its subject matter has been incorporated into Claim 1. The Office Action rejected Claim 21 on the basis that Wallman teaches the use of a trial order for discovery. Applicant has considered the cited portions of Wallman at Col. 16, lines 2-20; Col. 13, lines 20-38; Col. 18, lines 13-16; and Col. 30, lines 32-46, and disagrees that these passages teach anything about trial orders as claimed. Claim 22 is dependent on Claim 1, and further recites "wherein the report also indicates the price at which the trial order would have been paired if it had been a regular order."

Wallman does not teach or suggest each and every feature of Claim 1, and thus cannot support a *prima facie* rejection of Claim 1 under 35 U.S.C. § 103(a). Claim 1 should be allowed.

Patentability of Claims 2-20, 22-92, and 98-111

Claims 2-20, 22-92, and 98-111 incorporate all the features of Claim 1 and thus should also be allowed, at least for the same reasons as Claim 1. In addition, applicant submits that Claims 2-92 and 98-111 are also patentable for the additional subject matter they recite, which is not taught or suggested by the prior art. Extensive detail regarding the patentability of the dependent claims was provided in applicant's last response submitted February 5, 2007. Applicant has reviewed the arguments presented in the present Office Action, but remains convinced that the dependent claims present patentable subject matter. The additional disclosures of Korhammer, Gutterman, Jain, May, and the "More" article are unavailing in combination with Wallman to set forth a *prima facie* case of obviousness of dependent Claims 2-20, 22-92, and 98-111.

Claims 2-20, 22-92, and 98-111 should be allowed.

Patentability of Claims 112-126

For convenience of examination, new Claim 112 is repeated as follows:

112. A method for enabling multiple orders of a user to interact with at least one market process, comprising:

configuring multiple trading processes, wherein each trading process is configured in accordance with an order in the user's multiple orders, and wherein each order identifies at least one item for trading;

automatically performing, at each trading process, market discovery according to a discovery strategy selected from a plurality of discovery strategies by the user, wherein the discovery strategies are configured to obtain market information for the item in the order according to a different discovery methodologies, and

automatically acting upon the order at each respective trading process according to an action strategy selected from a plurality of action strategies by the user,

wherein the at least one market process and the multiple trading processes are software programs that exist independently of each other, are separately executable, and are operative on the same trading platform.

Applicant has studied the Wallman, Korhammer, Minton, Gutterman, Jain, and May patents, as well as the "More" article, and respectfully submits that Claim 112 is in condition for allowance. The Office Action cited the portfolio asset allocation and alleged multiple and intra-day investment decisions of the investor (Col. 11, lines 25-65; Col. 12, lines 29-42; Col. 25; and Col. 20, lines 59-60) as disclosing the features of Claim 112, but applicant disagrees. Nowhere does Wallman or the other cited art discuss a market process and multiple trading processes that are "software programs that exist independently of each other, are separately executable, and are operative on the same trading platform." Care must be taken to distinguish between a conventional software program that submits data representing orders to a market and trading processes that are each software programs themselves that exist independently of each other, are separately executable, and are operative on the same trading platform as the market process. See, e.g., page 4, lines 9-15, of the present application. The elements recited in Claim 112 are neither taught nor suggested in the prior art.

Additionally, Claims 113-116 incorporate all the features of Claim 112 and thus should be allowed at least for the same reasons as Claim 112. Applicant submits that Claims 113-116 are also patentable for the additional subject matter they recite, which is not taught or suggested by the prior art.

Claims 117-121 are directed to a computing system and are allowable for reasons similar to those given above with respect to Claims 112-116. Likewise, Claims 122-126 are directed to a computer-accessible medium and are allowable for reasons similar to those given above with respect to Claims 112-116.

Patentability of Claims 127-128

Claims 127 and 128 are respectively directed to a computing system and a computer-accessible medium, and include elements similar to Claim 1. For the same reasons given above with respect to Claim 1, Claims 127 and 128 are also patentable over the prior art. Allowance of Claims 127 and 128 is requested.

CONCLUSION

The application is in condition for allowance. Withdrawal of the claim rejections under 35 U.S.C. § 103(a) is respectfully requested. Should any issues remain needing resolution prior to allowance of the application, the Examiner is invited to directly contact the undersigned counsel by telephone.

Respectfully submitted,

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